

Serial No.: 10/017,242
Attorney Docket No.: F-419

Patent

REMARKS

1. Status of Claims

Claims 1-22 were pending in the Application. Applicants have amended claim 1 and canceled claims 2, and 10-11 without prejudice or disclaimer and added new claims 23-25. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants respectfully submit that no new matter is added. Accordingly, claims 1, 3-9 and 12-25 will remain pending in the application.

2. Claim Rejections

Starting on page 2 of the Office Action, the Examiner rejected claims 1, 7, 9 and 12-13 under 35 U.S.C. 102(e) as allegedly anticipated by U.S. Patent No. 6,557,045 B1 to Tsukui, et al. ("Tsukui '045").

Applicants respectfully traverse the rejection.

However, solely in order to expedite prosecution, Applicants have amended independent claim 1 to recite "determining the e-mail address formatting rule for the unique identifier portion of the e-mail address based on the gathered e-mail address data" and the rejection is moot. Support for the amendment can be found at least at page 9, lines 25-26 of the specification.

With regard to the Tsukui '045 reference, the reference describes methods focusing on quick entry of known elements for speedy data entry, not for determining previously unknown e-mail addresses. Importantly, the methods described in Tsukui '045 fail and terminate for unknown user names of a particular e-mail domain.

Dependent claims 7, 9 and 12-13 are patentable over the cited reference for at least the same reasons.

Furthermore, with regard to claim 7, which recites "determining whether the identifier portion is consistent with one or more known e-mail address formatting rules", the Tsukui '045 reference does not describe performing any format determination on the identifier portion of the e-mail address.

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Furthermore, with regard to claim 12 that recites:

“comparing a first sub-portion of the identifier portion to the list of known first names; and
comparing a second sub-portion of the identifier portion to the list of known last names”

the Tsukui '045 reference does not contemplate sub-portions of the identifier portion of the e-mail address.

Accordingly, Applicants respectfully submit that currently pending claims 1, 7, 9 and 12-13 are in condition for allowance and respectfully request that the Examiner withdraw the rejection.

Starting on page 5 of the Office Action, the Examiner rejected claims 2 and 19 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,557,045 B1 to Tsukui, et al. (“Tsukui '045”) in view of U.S. Patent Application Publication No. 2003/0225850 by Teague (“Teague '850”).

Applicants respectfully traverse the rejection. Applicants have canceled claim 2 without prejudice or disclaimer and submitted new claim 25 directed toward the subject matter of original claim 2.

Applicants respectfully submit that the Teague '850 reference is not available as prior art against the present application because it was filed May 28, 2003. Even if Teague '850 were entitled to the filing date of the related provisional application, which has not been established, the effective filing date would only be May 28, 2002 and the reference is not available as prior art. Accordingly, Applicants submit that the Examiner has not put forth a prima facie obviousness rejection.

Accordingly, Applicants respectfully submit that claim 19 and new claim 25 are in condition for allowance and respectfully request that the Examiner withdraw the rejection.

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Starting on page 7 of the Office Action, the Examiner rejected claim 3 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,557,045 B1 to Tsukui, et al. ("Tsukui '045") in view of U.S. Patent No. 6,654,779 B1 to Tsuei ("Tsuei '779").

Applicants respectfully traverse the rejection. Applicants respectfully submit that the claim is patentable for at least the reasons discussed above with reference to claim 1.

Furthermore, Applicants respectfully submit that the cited references are not properly combined. The purported motivation to combine is to "facilitate delivery of e-mail when a person obtains a new address and his or her old e-mail address becomes invalid." However, the cited references do not even contemplate determining the format of the user name portion of an address in a particular domain, not for a change of domain.

Accordingly, Applicants respectfully submit that claim 3 is in condition for allowance and respectfully request that the Examiner withdraw the rejection.

Starting on page 8 of the Office Action, the Examiner rejected claims 4-6 and 20-22 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,557,045 B1 to Tsukui, et al. ("Tsukui '045") in view of U.S. Patent No. 6,829,607 B1 to Tafoya, et al. ("Tafoya '607").

Applicants respectfully traverse the rejection. Applicants respectfully submit that the claims are patentable for at least the reasons discussed above with reference to claims 1 and 7.

Accordingly, Applicants respectfully submit that claims 4-6, 8 and 20-22 are in condition for allowance and respectfully request that the Examiner withdraw the rejection.

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Starting on page 14 of the Office Action, the Examiner rejected claims 14 and 16 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,557,045 B1 to Tsukui, et al. ("Tsukui '045") in view of U.S. Patent No. 5,329,405 to Hou, et al. ("Hou '405").

Applicants respectfully traverse the rejection. Applicants respectfully submit that the claims are patentable for at least the reasons discussed above with reference to claims 1 and 7.

Furthermore, Applicants respectfully submit that the cited references are not properly combined. Hou '405 describes methods related to content addressable memory and one of skill in the art would not look to Hou '405 to modify Tsukui '045.

Accordingly, Applicants respectfully submit that claims 14 and 16 are in condition for allowance and respectfully request that the Examiner withdraw the rejection.

Starting on page 17 of the Office Action, the Examiner rejected claims 15 and 17-18 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,557,045 B1 to Tsukui, et al. ("Tsukui '045") in view of U.S. Patent No. 5,329,405 to Hou, et al. ("Hou '405") and in further view of U.S. Patent No. 6,829,607 B1 to Tafoya, et al. ("Tafoya '607").

Applicants respectfully traverse the rejection. Applicants respectfully submit that the claims are patentable for at least the reasons discussed above with reference to claims 1 and 7.

Furthermore, Applicants respectfully submit that the cited references are not properly combined. Hou '405 describes methods related to content addressable memory and one of skill in the art would not look to Hou '405 to modify Tsukui '045.

Accordingly, Applicants respectfully submit that claims 15 and 17-18 are in condition for allowance and respectfully request that the Examiner withdraw the rejection.

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Regarding new claim 25, Applicants respectfully submit that the claim incorporates the limitations of original claim 2, that stands rejected over Teague that is not available as prior art against this application. Accordingly, Applicants respectfully submit that new claim 25 is in condition for allowance.

Accordingly, Applicant submits that the invention as presently claimed in claims 1, 3-9 and 12-25 is in condition for allowance.

3. Allowable Subject Matter

Applicants gratefully acknowledge the indication that claims 10-11 claim allowable subject matter on page 20 of the Office Action. Applicants have presented new claim 23 including all of the limitations of former claim 10 and new claim 24 including many of the limitations of former claim 11 including those of original claim 1 and original dependent claim 11.

Applicants respectfully submit that new claims 23-24 are allowable for at least the reasons indicated regarding original claims 10-11.

4. Conclusion Of Remarks

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicants at (203) 924-3180.

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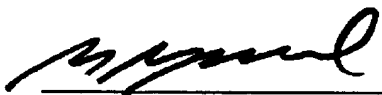
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5. Authorization

No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-419.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-419.

Respectfully submitted,



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